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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---------------------------------|---------------------|------------------|
| 10/613,341 | 07/03/2003 | Neil Andrew Abercrombie Simpson | MRKS/0093 | 5149 |

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EXAMINER

NICHOLSON, ERIC K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3679

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/613,341 | Applicant(s) SIMPSON ET AL. | |
| | Examiner Eric K Nicholson | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 30,34-36 and 40-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,31,32,37-39 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/03 2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 40,42-46, noted by applicant, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse on March 8, 2004. Further, claims 30,34-36 and 41 also are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention as review of the claimed subject matter corresponds to the non-elected subject matter.

Drawings

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “sealing member(s) of claims 20-29 must be shown or the feature cancelled from the claim. No new matter should be entered.

Claim Rejections –35 USC § 112

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, “the intended direction of rotation of the rotary expansion tool” lacks proper antecedent basis. In claim

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4-18,31-33,37-39 and 47 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 4,822,081 to Blose. The Blose coupling includes male threaded portion 12 and female threaded portion 13 wherein the thread portions are dovetail threads having flanks inclined at an angle of greater than 10 degrees. See figs. 1-4 and 6-8 for the dovetail threads and column 7, lines 14-57 disclosing flanks greater than 10 degrees and also the angles claimed in claims 4-9. As to claim 10, see. Fig. 6. As to claim 11 see fig. 11 and column 4, lines 50-55. As to claims 12-18 see Fig. 6 which illustrates the undercut groove for the leading portion of the male member and also the groove and seal member in the female member.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,409,175 to Evans in view of U.S. patent 4,822,081 to Blose. The Evans patent discloses the claimed device with male threaded portion 26 and female threaded portion 27 wherein the thread portions are hooked (fig. 7 and column 3, lines 1-57) however the hooked threads are not dovetail with flanks angles greater than 10 degrees. As noted above the Blose threaded coupling discloses that it is known in the art to provide a similar type coupling with the dovetail threads having flanks greater than 10 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the hooked thread of Evans with the dovetail thread as taught by Blose, in order to provide a more secure coupling by allowing high axial compression loading while controlling deformation in the threaded joint.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Especially note the expandable tubular connections using dovetail threads of Sivley, IV patents 6,554,287 and 6,607,220 and published application 2003/0067166.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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4/20/04


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Primary Examiner
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